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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/833,506	04/07/1997	ROBERT WEBBER	14291	2615
28061	7590	09/06/2006	EXAMINER	
THEODORE J. BIELEN JR. 1390 WILLOW PASS ROAD SUITE 1020 CONCORD, CA 94520			HUFF, SHEELA JITENDRA	
			ART UNIT	PAPER NUMBER
			1643	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/833,506

Applicant(s)

WEBBER, ROBERT

Examiner

Sheela J. Huff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 107-122 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 107 and 110-114 is/are allowed.
- 6) ☒ Claim(s) 108, 109 and 115-122 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

The amendment filed on 8/11/06 has been considered. Applicant's arguments are deemed to be persuasive-in-part.

Claims 107-122 are pending.

The double patenting rejection is withdrawn in view of the terminal disclaimer.

The rejection under 35 U.S.C. 112, first paragraph, (Parts 2 and 3) are withdrawn in view of applicant's amendment.

The art rejection is withdrawn in view of the declaration.

Information Disclosure Statement

The information disclosure statement filed 8/11/06 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statement filed 8/11/06 fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When

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claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 106 (found on page 4 of the amendment filed 8/11/06) been renumbered claim 122.

Response to Arguments/New Grounds of Rejection

Sequence listing

On page 32 the sequence at region 25-42 needs a SEQ ID No.

Applicant argues that SEQ ID NO. 29 on page 34 covers region 25-42. Applicant is directed to page 32 of the substitute specification filed 8/17/01. (Applicant's reference to page 34 refers to the originally filed specification. Applicant has since filed a substitute specification on 8/17/01 and this is the cope that needs to be looked at). Page 32 clearly shows that Seq ID NO. 29 covers 37-54 not 25-42. This is corroborated by the sequence listing filed 12/2/99.

Claim Rejections - 35 USC § 112

Claims 109, 114, 119 and 122 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Item "a" and "f" from the previous action remain and are re-iterated below as "a" and "b".

a. In claim 109, the third sequence needs a SEQ Id No.

Applicant states that SEQ ID NO. 29 covers region 25-42. Seq ID NO. 29 covers 37-54 not 25-42--see explanation above.

b. In the claims the phrase "selected from the group consisting essentially of" is an improper Markush group. The proper phrasing is --selected from the group consisting of--. See claims 114 and 119.

c. Claim 122 is indefinite in failing to set forth the requisite steps, reagents and parameters of the claimed methods with the required particularity. Methods claims need not recite all operating details but should at least recite positive, active steps so that the claims set out and circumscribe the method with a reasonable degree of precision and particularity. The language of claim 122 is not as precise as the subject matter permits such that one may reasonably know what will infringe and what will not infringe the claims. The claim fails to include specific reactant and final products, reagents and most importantly coherent steps.

Claim Rejections - 35 USC § 112

Claims 108-109 and 115-121 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The reasons for this rejection are of record in part 1 of the 35 U.S.C. 112, first paragraph, rejection made in the paper mailed 2/10/06.

Applicant argues that the amendment to the claims overcomes this rejection. It does not.

Allowable Subject Matter

Claims 107 and 110-114 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J. Huff whose telephone number is 571-272-0834. The examiner can normally be reached on Monday, Tuesday and Thursday from 7am to 1pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sheela J Huff
Primary Examiner
Art Unit 1643

sjh